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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/892,287

06/26/2001

Jennifer L. Hillman

PF-0334-2 DIV

2779

27904

7590

06/13/2002

INCYTE GENOMICS, INC.  
3160 PORTER DRIVE  
PALO ALTO, CA 94304

EXAMINER

ROARK, JESSICA H

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 06/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/892,287

Applicant(s)

HILLMAN ET AL.

Examiner

Jessica H. Roark

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,11 and 30-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,11 and 30-45 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. Applicant's Preliminary Amendment, filed 6/26/01 is acknowledged.  
Claims 2-10, 12-29 and 46-47 have been cancelled.  
Claims 1, 11 and 30-45 are pending and currently under consideration.

### *Sequence Compliance*

2. The instant application appears to be in sequence compliance for patent applications containing nucleotide sequence and/or amino acid sequence disclosures.

### *Drawing Requirement*

3. Formal drawings have been submitted which fail to comply with 37 CFR 1.84.  
Please see the enclosed form PTO-948.

### INFORMATION ON HOW TO EFFECT DRAWING CHANGES

#### **A. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

#### **B. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

### **Timing of Corrections**

*Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.*

***Restriction Requirement***

4. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claim 1, drawn to a polypeptide comprising SEQ ID NO:1 and variants thereof, classified in Class 435, subclass 183.

II. Claims 11, 31-32, 34, 36-43, drawn to an antibodies to the polypeptide of SEQ ID NO:1, compositions thereof, and methods of making the antibodies, classified in Class 530, subclass 387.1; Class 424, subclass 130.1; and Class 435, subclass 326.

III. Claims 30 and 44, drawn to a method/diagnostic test for a condition associated with expression of the polypeptide of SEQ ID NO:1, each comprising detecting the polypeptide in a biological sample; classified in Class 436, subclass 63 and Class 435, subclass 7.1.

IV. Claims 33 and 35, drawn to a method of diagnosing a condition associated with expression of the polypeptide of SEQ ID NO:1 by administering an antibody to the polypeptide to a subject, classified in Class 424, subclass 130.1 and Class 435, subclass 7.1.

V. Claim 45, drawn to method for using an antibody to purify the polypeptide of SEQ ID NO:1 from a sample; classified in Class 530, subclass 413.

These Inventions are distinct for the following reasons:

5. Groups I and II are different products. A polypeptide and antibodies to that polypeptide differ with respect to their structures and physicochemical properties; therefore each product is patentably distinct.

6. Groups III-V are different methods. Each method differs with respect to one or more of the ingredients, method steps, and endpoints involved; therefore, each method is patentably distinct.

7. Groups (I and II) and (II and III/IV/VI) are respectively related as product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case:

the polypeptide of Group I can be used as a phosphatase in addition to the production of antibodies, and the antibody of Group II can be used in any of the methods of Groups III-V, e.g. for purifying the protein, or for detecting the protein in complex biological samples without purification.

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8. These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. Further, even though in some cases the classification is shared, a different field of search would be required based upon the structurally distinct products recited and the various methods of use comprising distinct method steps. Therefore restriction for examination purposes as indicated is proper.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark whose telephone number is (703) 605-1209. The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Jessica Roark, Ph.D.  
Patent Examiner  
Technology Center 1600  
June 11, 2002

*Phillip Gambel*  
PHILLIP GAMBEL, PH.D.  
PRIMARY EXAMINER  
*Tech Center 1600*  
*6/14/02*